



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,659	10/06/2003	Tae-Kyung Kim	02-ASD-270 (EM)	4114

200 7590 10/05/2005

EATON CORPORATION
EATON CENTER
1111 SUPERIOR AVENUE
CLEVELAND, OH 44114

EXAMINER

ORTIZ, ANGELA Y

ART UNIT	PAPER NUMBER
----------	--------------

1732

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/679,659

Applicant(s)

KIM, TAE-KYUNG

Examiner

Angela Ortiz

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is unclear how the pocket is provided when the second gasket is disposed adjacent the first gasket; in claim 1, it is unclear if the second surface is sealed to form a composite or if it is used as a molding member.

In claim 1, a gasketed joint is set forth in the preamble, but is not formed in the steps being claimed.

In claim 6, it is unclear how the cavity is formed.

Claim Rejections - 35 USC § 103

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 1732

Claims 1, 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parrish et al., USP 3,029,730.

The cited reference substantially teaches the basic claimed method of sealing a gap between two members, shell 10 and plate 18, which are assembled to form a composite product. Shell 10 and plate 18 are assembled but separated by two sealing gaskets 14. The assembly is placed between two mold plates 12 and 16 for compressing the assembly during curing of the sealant material. A liquid curable sealant material 24 is provided through the mold and into the cavity between the assembled members. After the resin has cured, the mold is opened and the composite product is removed from the mold. Note that during application of the sealant, pressure is continuously applied until the sealant is cured. See col. 3, lines 5-75.

The reference does not set forth the intended use of sealing a gasketed joint per se, as set forth in the preamble of the claim, or the step of placing the second gasket adjacent the first gasket.

The preamble has not been given patentable weight in this rejection, as the steps performed do not reflect back to the first line of the claim.

With respect to the claimed step of placing the gaskets adjacent, note that adjacent is a term of relativity and such is deemed met by the art in that the area between the gaskets similarly defines a cavity (or pocket) to be filled by the sealant material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to so place the gaskets in any conventional manner to create a boundary for receiving the molding resin material as desired.

Art Unit: 1732

With respect to claim 3, see col. 3, line 11.

With respect to claim 4, note that while other materials are shown in the reference, the use of silicone gels is conventional in the art and would have been an obvious alternative to those set forth in the reference, as they yield similar results. See col. 4, lines 48-55.

With respect to claim 5, see col. 3, line 26.

With respect to claims 6-7, note that the reference teaches that the gaskets can be placed as desired at col. 3, lines 65-72; it would have been obvious to form a pocket of any conventional design as such is well within the level of ordinary skill in the art.

With respect to claim 8, note that the reference teaches using rubber gaskets at col. 2, line 66; such materials are well known in the art for having stiffer compressibility properties and it would have been obvious to one of ordinary skill in the art at the time the invention was made to include as a gasket choice for achieving the desired compressibility.

Claims 1, 2, 3, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill et al., USP 6,431,549.

The cited reference substantially teaches the basic claimed method of sealing joints between two components, wherein the components are readable on the claimed members. First and second components are provided with a plurality of openings, wherein the openings cooperate to align the components through the use of pins and other means. Between the components a gap is formed and a plurality of sealant

Art Unit: 1732

carrier members, readable on the claimed gaskets, may be provided. The sealant carrier members may be sized and shaped to follow the path of an elongated gap that exists between the first and second components. In the method, as depicted in figure 11, component 24 is assembled to component 14 by providing sealant strips 204 within the gap between the components. A compressible sealant 284 is provided and spread to seal a gap 28 between the components. The preferred sealant used is urethane, which is heat curable, see col. 11, lines 55-65. See also col. 13, line 50 to col. 14, line 15.

The reference does not set forth forming a pocket between the edge of a first and second gasket as claimed, per se.

Note that figures 9 and 10 show an embodiment of the strip having a pattern of openings within the strip, wherein openings are formed for receiving the sealant material to be applied. It would have been obvious to one of ordinary skill in the art at the time the invention was made to so include forming a pocket as claimed, in view of the patterned openings shown in the applied reference, for receiving the sealant material as shown.

With respect to claims 2-3, note that the reference teaches applying the sealant in the form of a bead at col. 10, lines 5-13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include any conventional bead form, including pellet or semi-liquid, for equivalently applying the sealant material as desired.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5 of copending Application No. 10/673,807. Although the conflicting claims are not identical, they are not patentably distinct from each other because both set forth a method of sealing a first and second member by molding sealant material between two gaskets on at least one member.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

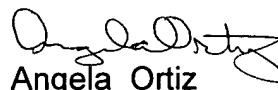
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USP's 4581089; 4770836; 5116558.

Art Unit: 1732

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela Ortiz whose telephone number is 571-272-1206. The examiner can normally be reached on Monday-Thursday 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Angela Ortiz
Primary Examiner
Art Unit 1732

ao